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10/090,120	02/28/2002	Gerald Steiner	GEST.001A	3606
20995	7590	01/15/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			NGUYEN, KIMBERLY D	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			2876	

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/090,120

Applicant(s)

STEINER, GERALD

Examiner

Kimberly D. Nguyen

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 13 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Amendment*

1. Acknowledgement is made of Amendment of 2 October 2003.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4, and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Kadaba et al. (US 6,285,916; hereinafter “Kadaba”).

Re claim 1: Kadaba teaches a package for mailing items from a merchant/sender to a customer/recipient, the package/item comprising:

at least one surface, the surface having a barcode 30 thereon; wherein the barcode identifies the customer i.e. the identity of the intended recipient (fig. 3; col. 5, line 56 through col. 6, line 9).

Re claims 4 and 16: Kadaba teaches a package for mailing from a merchant to a customer, wherein scanning the barcode 30 enable the merchant to identify item (i.e., the package bearing the barcode 30 thereon) or categories of items in which the customer is interested.

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Re claims 14-15: Kadaba teaches the customer is identified by name (i.e., Recipient's name: John Doe in figs. 5D and 5F), by address (i.e., Recipient's location in figs. 5D and 5F).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kadaba in views of Diedrich (US 5,893,512) and Nozaki et al. (US 6,349,194; hereinafter "Nozaki"). The teachings of Kadaba have been discussed above.

Re claim 2: Although, Kadaba teaches a "scan history" containing the package/parcel information such as received by, sent by, or in transit to a particular person (col. 8, lines 12-15).

Kadaba fails to teach or fairly suggests the barcode includes a complete order and return history for the customer.

Diedrich teaches merchandise return tracking indicia 62, 63, which can provide a return address, customer information, etc., wherein the merchandise return tracking indicia 62, 63 is in a machine readable form, such as a barcode (fig. 1; abstract; col. 5, lines 13-18).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the barcode containing merchandise return information as taught by Diedrich to the teachings of Kadaba in order to provide a more informative system to the customer/merchant to further aid the customer for easily returning the merchandise.

Kadaba as modified by Diedrich fails to specifically teach the barcode including an order history of a customer.

Nozaki teaches a barcode, which includes an order history of a customer (col. 6, lines 24-46).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the barcode containing the order history of the customer as taught by Nozaki to the teachings of Kadaba as modified by Diedrich in order to provide a more informative system to the customer/merchant to further aid the customer/merchant with a complete order history.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kadaba in view of Manduley et al. (US 4,724,959; hereinafter "Manduley"). The teachings of Kadaba have been discussed above.

Kadaba fails to specifically teach the package is marked by the merchant with the return mailing address of the merchandise.

Manduley teaches a return address (14 in fig. 1), wherein the customer does not need to address the mailer before returning the merchandise (see col. 2, lines 8-12; col. 2, line 51 through col. 3, line 11), which is the return address (14 in fig. 1) is affixed/marked by the merchant.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the return address which is marked/attached by the vendor as taught by Manduley to the teachings of Kadaba in order to provide convenience to the user to return the merchandise without the need of writing the vendor's address from the user.

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7. Claims 5-6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markman (US 5,962,834) in view of Hauser et al. (US 6,536,659; hereinafter “Hauser”).

Markman teaches a method of tracking an order history of a customer, the method comprising the steps of:

providing a package including a barcode that identifies the customer (i.e. shipping address for the customer) (col. 2, lines 7-22);

scanning the barcode to identify the customer (col. 2, lines 7-22);

updating the customer’s order history (figs. 1-2; col. 5, line 62 through col. 6, line 40; col. 8, line 63 through col. 9, line 18).

Markman fails to teach or fairly suggests the return history of the customer.

Hauser teaches a method of tracking a return of a customer, the method comprising:

receiving the package from the customer, the package containing returned items;

inputting the returned items into an inventory database; and

updating the customer’s return history (figs. 1-6; abstract; col. 2, lines 9-38; col. 3, line 43 through col. 6, line 17).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the tracking returned merchandise system as taught by Hauser to the teachings Markman in order to provide a method and system for handling/tracking a returned merchandise from a customer.

8. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westrope et al. (US 5,721,832; hereinafter “Westrope”) in view of Deaton et al. (US 5,430,644; hereinafter “Deaton”).

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Westrope teaches a method of targeted advertising, the method comprising the steps of: accumulating information about orders placed by a customer (col. 3, lines 44-47); analyzing the information (col. 3, lines 55-61); mailing the customer an item in response to a request by the customer (col. 7, lines 28-37; col. 2, line 62 through col. 4, line 18).

Although, Westrope teaches a customer profile marketing data, which is updated to include any order placed at that time (col. 8, lines 17-19). Westrope fails to specifically teach the steps of predicting, based on the information, what type of items the customer is likely to purchase in the future; providing the customer with advertising directed toward those items by mail.

Deaton teaches a method of targeted advertising, wherein the method comprising the steps of predicting, based on the information, what type of items the customer is likely to purchase in the future; providing the customer with advertising (i.e., Point-of-Sale coupons and Direct-Mail coupons) directed toward those items by mail (for example, detecting whether or not items have been purchased from the meat department, dairy department or deli. Based upon data stored within the computer, the decision is then made as to whether to award a coupon and what type of coupon to award... col. 69, lines 7-12) (see figs. 18A-C; col. 65, lines 55-58; col. 66, lines 35-58; and col. 68, line 65 through col. 69, line 45).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the steps of predicting what type of items the customer is likely to purchase in the future and providing the customer with advertising toward those items by distributing Point-of-Sale coupons and Direct-Mail coupons as taught by Deaton to the

teachings of Westrope in order to induce infrequent shoppers to shop and also maintain the existing customers (col. 66, lines 42-45).

9. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westrope as modified by Deaton as applied to claim 7 above, and further in view of Muscoplat (US 5,409,441). The teachings of Westrope as modified by Deaton have been discussed above.

Re claims 8 and 10-12: Although, Deaton teaches using the barcode on the product/package (col. 10, lines 34-36) to detect which products are being purchased, and which departments are being shopped by the customer (col. 69, lines 4-7). Westrope as modified by Deaton fails to specifically teach a barcode that identifies the customer.

Muscoplat teaches a barcode (164 in fig. 14; or 181 in fig. 15), which identifies the customer (i.e., the customer's barcode account number on coupon; col. 34, lines 18-41; and col. 49, lines 3-4).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate barcode identifying the customer as taught by Muscoplat to the teachings of Westrope as modified by Deaton in order to provide convenience (i.e., to access customer's information at any time through the barcode) to the account management to handle customer's delivery.

Re claim 9: Westrope teaches the step of receiving an order from the customer (i.e., customer inquiry generates an order for a specific product... col. 3, lines 44-45).



***Allowable Subject Matter***

10. Claims 13 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to specifically teach the barcode includes information on orders and returns for the customer as set forth in claim 13 and/or the advertising is selected based at least in part on the return history of the customer as set forth in claim 19.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McEvoy et al. (US 6,292,785) teaches business system and method of compiling mailing list of interested customers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 703-305-1798. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-8792.

KDN


  
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2 January 2004



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